

Serial No. 10/828,977
Response to Final Office Action mailed June 1, 2006

Filed: April 21, 2004

REMARKS

Claims 5-27 are pending in the present application. Reconsideration of the pending Claims is respectfully requested in view of the following remarks.

The 35 U.S.C. §112 first paragraph rejections

Claims 5-13 and 19-27 were rejected pursuant to 35 U.S.C. §112 first paragraph as failing to comply with the written description requirement since Claims 5 and 19 include subject matter not described in the specification in a way that conveys Applicant had possession of the claimed invention.

Specifically, in Claim 5 the language "wherein said control unit is further operable to attempt to register to said first mobile communication network only when said voice communication is not presently in progress," was objected to. Paragraph 48 of Applicant's specification describes:

[0048] As shown in fig.8, control unit 510 determines whether a mobile terminal 50 user is calling through second mobile communication network 20 (Step SC1), and repeats the Step SC1 process while the determination result in Step SC1 is "Yes". This is because a call is disconnected if the location registration area of mobile terminal 50 is changed from first mobile communication network 10 to second mobile communication network 20 while mobile terminal 50 is in use.

With regard to Claim 19, the language "transmitting from said mobile terminal to said first mobile communication network, a notification including an identifier only when voice communication is determined to not presently be in progress," was objected to.

As reprinted above and illustrated in Step SC1 of Figure 8, paragraph 48 and Figure 8 of Applicant's specification describe that the control unit determines whether a user is calling before proceeding with attempting to register (Claim 5), or transmitting a notification (Claim 19). Thus, the objected to subject matter of Claims 5 and 19 is supported by at least Figure 8 and paragraph

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48 of Applicant's specification, and withdrawal of the rejection of Claims 5-13 and 19-27 is respectfully requested.

The 35 U.S.C. §103(a) Claim Rejections

Claims 14-17 were rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,594,242 to Kransmo (hereinafter referred to as Kransmo) in view of U.S. Patent No. 6,697,620 to Lamb et al. (hereinafter referred to as Lamb). In addition, Claim 18 was rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over Kransmo and Lamb, and further in view of U.S. Patent Application Publication No. US 2001/0012776 A1 to Chandler et al. (hereinafter referred to as Chandler). Applicant respectfully traverses these rejections since all of the limitations described in Claims 14-18 are not taught, suggested, or disclosed by the cited prior art, either alone or in combination. Thus, a *prima facie* case of obviousness has not been established.

Claim 14 describes a management device operable to selectively update said location registration data in response to receipt from each of said mobile terminals of a notification of a current registration of a respective mobile terminal to at least one of said first mobile communication network or said second mobile communication network. In the office action mailed June 1, 2006, it was asserted that a Universal Location Service Register (ULSR) as described by Lamb anticipates these limitations.

Applicant respectfully disagrees with these assertions since Lamb is describing communication between a mobile phone and a Mobile Switching Center (MSC), and separate, and entirely different, communication between the MSC and the ULSR. (Col. 6 lines 23-50) Specifically, Lamb describes that the ULSR updates a database in response to receipt of a LOCATION_UPDATE message from the MSC that includes a request to register a mobile phone, after the MSC authenticates the mobile phone based on information received from the ULSR in

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response to a SEND_PARAMETERS message. (Col. 6 lines 25-38) Claim 14, on the other hand, describes a management device operable to update location registration data in response to receipt from each of said mobile terminals of a notification of a current registration. Clearly, Lamb's ULSR is not receiving anything from a mobile terminal and is instead receiving information only from an MSC. In addition, Lamb's ULSR is not receiving notification of a current registration as described in Claim 14, but is instead receiving a request, authorizing an MSC to proceed with registration of a mobile phone, and updating a database based only on the authorization and the anticipated registration (Col. 6, lines 33-50).

As described in at least paragraphs 38 and 41 of Applicant's specification, it is the control unit of the mobile terminal that manages and controls communication with the management device and activation of a communication network. Conversely, Lamb describes a system in which management and control of communication with a ULSR and registration of a mobile phone are performed with an MSC. In Lamb's system, a mobile phone simply sends a registration request, and it is the MSC that performs authorization and subsequent registration if authorized by a ULSR. To establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. See MPEP §2143.03.

In this instance, not only does Lamb fail to describe receipt by the ULSR of any communication from a mobile terminal, but also Lamb teaches away from such activity by describing that all communications with the ULSR related to updating the ULSR's database are performed by an MSC. In addition, Lamb clearly describes that ULSR is updated before a mobile phone is registered, which cannot be in response to receipt of a current registration as described in Claim 14. Thus, Lamb also teaches away from receipt of a current registration as described in Claim 14.

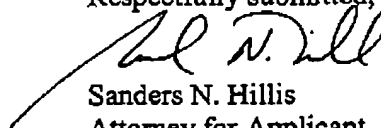
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In the office action mailed June 1, 2006, Claim 18 was rejected on the basis that Chandler described that transmission of said registration possibility information by said base station is adjustable in accordance with a distance of said base station from a center of said first mobile communication network, as described in Claim 18. Applicant respectfully traverses this assertion since paragraph 18 of Chandler is clearly describing determination of a delay in transmissions between base stations for purposes of determining a shortest route for a call (Paragraph 17), not adjustment of an interval of time between transmission of registration possibility information as described in Claim 18. In addition, Chandler describes distances between base stations and associated delay, not a distance of a base station from a center of a mobile communication network as described in Claim 18.

For at least the foregoing reasons, all of the limitations described in Claim 14 and the Claims dependent therefrom are not taught or suggested by the cited prior art, either alone or in combination. Thus, a *prima facie* case of obviousness has not been established for Claims 14-18. Accordingly, the present pending claims of this application are allowable, and Applicant respectfully requests the Examiner to issue a Notice of Allowance for this application. Should the Examiner deem a telephone conference to be beneficial in expediting allowance/examination of this application, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

Respectfully submitted,



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